

REMARKS

Claim Rejections

Claims 1, 3-12, 15-19 are rejected under 35 USC 103(a) as being unpatentable over Wang et al. (US 6,538,997) in view of Han et al. (US 2004/0100903). Claims 2, 13, 14 and 20 are rejected under 35 USC 103(a) as being unpatentable over Wang et al. (US 6,538,997) in view of Han et al. (US 2004/0100903), and further in view of Matsumoto (US 2001/0025314).

Claim Amendments

By this Amendment, Applicant has canceled claims 5-8 and 15-18 and has amended claims 1, 12 and 19 of this application. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

Claim 1

Independent claim 1 has been amended to recite that "if the second node comprises a network interface card (NIC), the second node transmits the reply frame **only when** a destination address of the received request frame comprises a MAC address of the second node" and "if the second node comprises a network switch, the second node transmits the reply frame when the destination address of the received request frame comprises a MAC broadcast address; if the second node comprises the network switch, the second node selectively transmits the reply frame when the destination address of the received request frame comprises the MAC address of the second node", which are not disclosed or suggested by Wang et al. and Han et al., alone or in combination. The newly added features of claim 1 are described in the first embodiment of the present application (See, paragraph [0025] of the specification). Furthermore, the newly added features of claim 1 are mostly based on claims 6-8 (now canceled). In the outstanding Office Action, the Examiner rejects each of claims 6-8 using the same rationale of "see fig 5a where the destination address is that of a MAC address, and a response frame is fwd as a result." However, Applicant notes that this rationale does not account for the fact that different types of the second node (e.g. NIC or network switch) operate in **different ways when deciding whether**

to transmit the reply frame. In fact, in amended claim 1, **when deciding whether to transmit the reply frame, the second node comprising the NIC operates in a different way from that comprising the network switch.** In comparison, **both Wang et al. and Han et al. fail to disclose or suggest the different ways of operation between different types of the second node.**

Thus, both Wang et al. and Han et al., alone or in combination, fail to disclose or suggest all of the limitations claimed in independent claim 1, so claim 1 is submitted to be in condition for allowance. Claims 2-4 and 9-11 depend from claim 1 and are submitted to be allowable for the same reasons.

Claim 12

Independent claim 12 has been amended to recite that **“if the second node comprises a network interface card (NIC), the second node transmits the reply frame *only when* a destination address of the received request frame comprises a MAC address of the second node”** and **“if the second node comprises a network switch, the second node transmits the reply frame when the destination address of the received request frame comprises a MAC broadcast address; if the second node comprises the network switch, the second node selectively transmits the reply frame when the destination address of the received request frame comprises the MAC address of the second node”**, which are not disclosed or suggested by Wang et al. and Han et al., alone or in combination. Based on the foregoing arguments as applied to claim 1, claim 12 is also submitted to be in condition for allowance. Claims 13-14 depend from claim 12, and are submitted to be allowable for the same reasons.

Claim 19

Independent claim 19 has been amended to recite that **“if the second network apparatus comprises a network interface card (NIC), the second network apparatus transmits the reply frame *only when* a destination address of the request frame comprises a MAC address of the second network apparatus”** and **“if the second network apparatus comprises a network switch, the second network apparatus transmits the reply frame when the destination address of the request frame comprises a MAC broadcast address; if the second network**

apparatus comprises the network switch, the second network apparatus selectively transmits the reply frame when the destination address of the request frame comprises the MAC address of the second network apparatus,” which are not disclosed or suggested by any of Wang et al. and Han et al., alone or in combination. Based on the foregoing arguments as applied to claim 1, claim 19 is submitted to be in condition for allowance. Claim 20 depends from claim 19, and is submitted to be allowable for the same reasons.

Matsumoto is cited as teaching that the first node re-transmits the request frame if not receiving the reply frame within a predetermined response time (a feature of dependent claims 2, 13, 14, and 20). In response, Applicant does not necessarily acquiesce to this characterization and notes that, in any event, the reference fails to provide the above-noted deficiencies of the remaining references to Wang et al. and Han et al.

It follows that even if the teachings of Wang et al., Han et al., and Matsumoto were combined, as suggested by the Examiner, the resultant combination does not teach or suggest the system, method, or apparatus as recited in claims 1, 12, and 19.

In considering the above, the Examiner is respectfully reminded that it is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious. The Supreme Court, in *KSR International Co. v. Teleflex Inc. et al.*, 550 U.S. 1, 82 USPQ2d at 1391 (2007), reaffirmed the framework of *Graham v. John Deere Co. of Kansas City* for determining obviousness under 35 U.S.C. 103. In that decision, the Supreme Court stated, at page 2:

In *Graham v. John Deere Co. of Kansas City*, 383 U. S. 1 (1966), the Court set out a framework for applying the statutory language of §103, language itself based on the logic of the earlier decision in *Hotchkiss v. Greenwood*, 11 How. 248 (1851), and its progeny. See 383 U. S., at 15–17. The analysis is objective:

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained;

and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Id.*, at 17–18.

While the sequence of these questions might be reordered in any particular case, the factors continue to define the inquiry that controls. If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under §103.

The Supreme Court, further explained that:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ("***[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness***"). *KSR* at 1396 (*Emphasis Added*).

Applicant submits that the above-presented arguments clearly indicate that the Examiner has failed to provide an "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" for combining selected elements of Wang et al. with selected elements of Han et al. and Matsumoto. *KSR* at 1396 (citing *In re Kahn* at 988). Clearly, such a combination is not an acceptable combination under 35 U.S.C. §103. The rejections of Applicant's claims as being rendered by the aforementioned combinations of references under 35 U.S.C. §103 are respectfully traversed.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: March 24, 2009

By: 
Demian K. Jackson
Reg. No. 57,551

TROXELL LAW OFFICE PLLC
P.O. Box 1370
Annandale, VA 22003
Telephone: 703 575-2711
Telefax: 703 575-2707

CUSTOMER NUMBER: 40144